

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Nathalie GUENNOUNI et al.) Group Art Unit: 1621
Application No.: 10/561,223) Examiner: M. Lao
Filed: February 27, 2007) Confirmation No.: 1602
For: METHOD OF PREPARING)
HALOGENOALKYLDIALKYL)
CHLOROSILANE)

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In complete response to the Restriction Requirement mailed September 12, 2007, and further to the Examiner Interview Summary of November 8, 2007, Applicants submit herewith a petition for one-month extension of time and the following response.

The Examiner sets forth a Restriction Requirement among two (2) groups of the claims as follows:

Group I: Claims 13-23 and 25-31 drawn to a process for the preparation of a haloalkyldialkylhalosilane of formula (1), with substituents, as recited therein; and

Group II: Claim 24, drawn to a catalytic system for the preparation of a haloalkyldialkylhalosilane of formula (1), with substituents, as recited therein.

Applicants respectfully traverse the above Restriction Requirement. Moreover, Applicants respectfully assert that the inventions of Groups I and II should properly be examined together.

Group I is directed to a process for the preparation of a haloalkyldialkylhalosilane of formula (1) and Group II is directed to a catalytic system

for the preparation of a haloalkyldialkylhalosilane of formula (1). Accordingly, Group I and Group II have the common feature of preparation of the haloalkyldialkylhalosilane of formula (1).

Applicants submit that in light of the above, the inventions of Groups I and II are closely related and that a proper search of any of the claims should, by necessity, require a proper search of the others. Thus, Applicants submit that all of the claims can be searched simultaneously, and that a duplicative search, with possibly inconsistent results, may occur if the restriction requirement is maintained.

Applicants submit that any nominal burden placed upon the Examiner to search accordingly to determine the art relevant to Applicants' overall invention is significantly outweighed by the public's interest in not having to obtain and study many separate patents in order to have available all of the issued patent claims covering Applicants' invention. The alternative is to proceed with the filing of numerous applications, each consisting of generally the same disclosure, and each being subjected to essentially the same search, perhaps by different Examiners on different occasions. This process would place an unnecessary burden on both the Patent and Trademark Office and on the Applicants.

Regardless of whether the two inventions are independent or distinct, Applicants respectfully assert that the Examiner need not have restricted the application. M.P.E.P. § 803 requires that "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Therefore, it is not mandatory to make a restriction requirement in all situations where it would be deemed proper.

In the interest of economy, for the Office, for the public-at-large, and for Applicants, reconsideration and withdrawal of the restriction requirement are requested.

Nevertheless, in order to comply with the requirements of 37 C.F.R. § 1.143, Applicants indicate below a provisional election of one group for examination. As such, Applicants elect, with traverse, to prosecute the invention of Group I, namely claims 13-23 and 25-31.

In light of the above, Applicants respectfully submit that claims 13-31 should be examined together.

Applicants have no intention of abandoning any non-elected subject matter and should it be necessary, Applicants expressly reserve the right to file one or more continuation and/or divisional applications directed to non-elected subject matter.

The Examiner is invited to contact the undersigned at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Dated: November 9, 2007

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